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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,321	04/28/2006	Nils Bottke	289331US0PCT	5175
22850	7590	05/19/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER OSULLIVAN, PETER G				
ART UNIT 1621		PAPER NUMBER		
NOTIFICATION DATE 05/19/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/577,321

Applicant(s)

BOTTKE ET AL.

Examiner

Peter G. O'Sullivan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-20 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 25 July 2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

Claims 12-20 are pending in this application which should be reviewed for error. In response to the requirement for restriction, applicants elected Group I, claims 12-18 with traverse. For the reasons of record, the restriction requirement is adhered to and claims 19 and 20 are held withdrawn from consideration.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Scheibel et al., WO 99/05244. Scheibel et al. disclose, for example, example 5 wherein 5-methyl-5-undecanol, 6-methyl-6-dodecanol and 7-methyl-7-tridecanol are dehydrated and benzene is alkylated with the lightly branched olefin mixture using a shape selective zeolite catalyst to yield an alkylaromatic compound which is then sulfonated producing a surfactant.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teaching of Scheibel et al., WO 99/05244, and Kott et al., WO 02/092737, taken with Steinbrenner et al., WO/029172). Scheibel et al. disclose improved alkyl aryl sulfonate surfactants which are: "in the middle ground between the old, highly branched, nonbiodegradable alkylbenzenesulfonates and the new linear types which are both more highly performing than the latter and more biodegradable than the former" (p. 3, bottom). The surfactants of Scheibel et al., are given by the formulae on pages 3 and 4. Scheibel et al. disclose the anticipating example of example 5 as noted above. Kott et al. is relied on to disclose additional examples of processes producing surfactants wherein a high percentage of the products contain methyl branching in positions greater than 4 (s., e.g. examples 1-3). The instant invention differs from the teaching of the first two references in that applicants claim the subject matter of claim 17 wherein the catalyst may be faujasite. Steinbrenner et al. disclose formation of olefins used for alkylation by the stages disclosed by applicants and further disclose a non-exhaustive list of alkylation catalysts to include mordenites, zeolite L, faujasite, etc. It would have been prima facie obvious at the time the invention was made to start with the teaching of the references, to react overlapping olefins with aromatics, especially in view of the anticipating example noted above, optionally using faujasite as a catalyst

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and to expect to produce alkylaromatics that when sulfonated would be useful as surfactants.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No.'s 10/490,218 and 10/343,835 in view of Scheibel et al., WO 99/05244, and Kott et al., WO 02/092737, and with Steinbrenner al, WO/029172). The instant claims differ from those of 10/490,218 and 10/343,835 in not specifically specifying fewer than 30% of the methyl branches are in the 2, 3, and 4 position and in the case of claim 17, not specifying a faujasite catalyst. The claims of the copending applications do claim formation of olefins used for alkylation using stages set forth in applicants' specification. The teaching of the references is as given above. It would have been

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prima facie obvious to start with the claimed inventions of 10/490,218 and 10/343,835, to make applicants' claimed processes and to expect to make surfactant alkylarylsulfonates.

This is a provisional obviousness-type double patenting rejection.

No claim is allowed.

Any inquiry concerning this communication should be directed to Peter G. O'Sullivan at telephone number (571)272-0642.

/Peter G O'Sullivan/

Primary Examiner, Art Unit 1621